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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/881,748	06/18/2001	Kunio Shiota	04853.0074	8762	
22852	7590 05/28/2004		EXAMINER		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER			BRUSCA, JOHN S		
LLP 1300 I STRE	ET. NW		ART UNIT	PAPER NUMBER	
	WASHINGTON, DC 20005			-	
			DATE MAILED: 05/28/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Advisory Action	09/881,748	SHIOTA ET AL.	
Advisory Action	Examiner	Art Unit	
	John S. Brusca	1631	
The MAILING DATE of this communication appe	ears on the cover sheet with the c	correspondence add	ress
THE REPLY FILED 19 May 2004 FAILS TO PLACE TH Therefore, further action by the applicant is required to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (condition for allowance; (2) a timely filed Notice of Appe Examination (RCE) in compliance with 37 CFR 1.114.	void abandonment of this applic 1) a timely filed amendment whi	cation. A proper re ch places the appli	ply to a cation in
PERIOD FOR RE	EPLY [check either a) or b)]		
a) The period for reply expires 5 months from the mailing date of b) The period for reply expires on: (1) the mailing date of this Adverse, however, will the statutory period for reply expire later the ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS 706.07(f). Extensions of time may be obtained under 37 CFR 1.136(a). The data have been filed is the date for purposes of determining the period of extensions of the shortened (b) above, if checked. Any reply received by the Office later than three meaning patent term adjustment. See 37 CFR 1.704(b).	visory Action, or (2) the date set forth in the nan SIX MONTHS from the mailing date on FILED WITHIN TWO MONTHS OF THE on which the petition under 37 CFR 1.1 is on and the corresponding amount of the distatutory period for reply originally set in	f the final rejection. E FINAL REJECTION. (136(a) and the appropriat e fee. The appropriate ex the final Office action; or	See MPEP e extension fee tension fee under (2) as set forth in
 1. ☐ A Notice of Appeal was filed on Appellant 37 CFR 1.192(a), or any extension thereof (37 CF 2. ☒ The proposed amendment(s) will not be entered be 	R 1.191(d)), to avoid dismissal		
(a) ☑ they raise new issues that would require furth		(see NOTE helow):	
(b) they raise the issue of new matter (see Note		(See 140 I E below),	
(c) ☐ they are not deemed to place the application issues for appeal; and/or	-	terially reducing or	simplifying the
(d) they present additional claims without cance	ling a corresponding number of	finally rejected clai	ms.
NOTE: See Continuation Sheet.			
3. Applicant's reply has overcome the following rejection.	ction(s):		
4. Newly proposed or amended claim(s) would canceling the non-allowable claim(s).	d be allowable if submitted in a s	separate, timely file	d amendment
5. ☑ The a) ☐ affidavit, b) ☐ exhibit, or c) ☑ request for application in condition for allowance because: see		sidered but does N	OT place the
6. The affidavit or exhibit will NOT be considered be raised by the Examiner in the final rejection.	cause it is not directed SOLELY	to issues which we	ere newly
7. For purposes of Appeal, the proposed amendment explanation of how the new or amended claims w			and an
The status of the claim(s) is (or will be) as follows	:		
Claim(s) allowed: none.			
Claim(s) objected to: none.			
Claim(s) rejected: <u>1 and 5-13</u> .			
Claim(s) withdrawn from consideration: 4 and 14.			

John S. Brusca
Primary Examiner
Art Unit: 1631

10. Other: ____

8. ☐ The drawing correction filed on ____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). <u>01 December 2003</u>.

Application No.

Continuation Sheet (PTOL-303) 09/881,748

Continuation of 2. NOTE: The proposed amendment will not be entered after final because the amendment raises new issues and does not place the application in better form for appeal. The proposed amendment is vague in that the proposed new limitation "a plurality of gene regions" could mean either regions within a single gene or a plurality of different genes. The applicants state that Duffy does not anticipate claims 1, 5, 7, and 11 because Duffy does not show obtain a DNA methylation pattern. However Duffy determines a plurality of sites of differential methylation in the examples at columns 21-28 which is all that is required by the instant claims. The applicants state that Duffy does not compare patterns after obtaining patterns as in the proposed amendment. Since the amendment has not been entered, the argument is not persuasive, and it is further not clear why Duffy does not show comparison of patterns after obtaining the pattern data. The applicants state Duffy does not show comparison to known types of cell, tissue, or nucleus, however Duffy compares to normal tissue which meets the limitations of the claims. The applicants state that Zhu does not show a correlation between methylation and phenotype of cells, however table 3 of Zhu shows a correlation between methylation levels and gene expression, and gene expression is a phenotype that is a differentiation state. The applicants state that Hertz does not show aspects of the preamble of claims 1 or 5. The preamble of claims 1 and 5 are not given weight for purposes of anticipation because the preamble does not affect the steps of the claimed method. Hertz shows the steps of the claimed method because Hertz compares the methylation state of different cells at a number of different loci.